REMARKS/ARGUMENTS

Double Patenting Rejection

Claims 20-25 and 30-34 are rejected as claiming the same invention as that of claims 1-14 of prior U.S. patent 6,751,667 ("the '667 patent"). Applicant traverses this rejection.

For the examiner to make out a statutory double patenting rejection under 35 U.S.C. § 101, the examiner must show that the rejected claims are drawn to the identical subject matter as the claims in the prior patent:

> In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. "Same invention" means identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel,* 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).
>
> A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist.

M.P.E.P. § 804 (*p.* 800-19).

Under any test, it is clear that the invention being claimed in claims 20-25 and 30-34 is not the same invention claimed in the '667 patent.

Claims 20-24 and 30-34 all recite two different types of memory, one faster than the other. Thus, claims 20-24 and 30-34 define the types of memory in terms of their speed relative to each other. One is faster than the other and, conversely, the other is slower than the one. No specific type of memory is required by claims 20-24 and 30-34. Both types of memory may be volatile, or both may be non-volatile, or one may be volatile and the other non-volatile. Claims 20-24 and 30-34 are not concerned with the types of memory used. They are concerned with the relative speeds of the types of memory.

In contrast, the claims of the '667 patent recite different types of memory for storing sub-fields, specifically volatile memory and non-volatile memory. No reference is made in the claims of the '667 patent to the relative speeds of the volatile and non-volatile memories. The claims of the '667 cover the situation where the non-volatile memory is faster than the non-volatile memory, but they also cover the situation where the volatile memory may be slower than the non-volatile memory. Relative speed is not the issue in the claims '667 patent – the type of memory is the issue.

Since the '667 patent claims type of memory but not relative speed, and since claims 20-24 and 30-34 claim relative speed but not type of memory, it follows that the '667 patent and claims 20-24 and 30-34 do not claim the same invention.

Applying the *Vogel* test underscores the point. Claims 20-24 and 30-34 cover embodiments where both forms of memory can be volatile. As long as one memory is faster than the other, claims 20-24 and 30-34 cover the embodiment. However, such an embodiment would not be covered by the claims of the '667 patent, since those claims recite both volatile and non-volatile forms of memory. Conversely, the claims of the '667 patent cover embodiments where both memories are of equal speed, whereas claims 20-24 and 30-34 cover memories of different speeds.

Because claims 20-24 and 30-34 do not claim the same invention under any test, the rejection of those claims lacks foundation. Withdrawal of the rejection is requested.

Rejection under 35 U.S.C. § 103(a)

Claims 16-19, 26-29, and 35-38 are rejected under 35 U.S.C. § 103(a) as obvious over U.S. patent 6,421,651 ("the '651 patent"). Applicant traverses this rejection. Claims 16, 18, 26, 35, and 37 are amended to more clearly recite that a predetermined identifier is divided into a number subfield and a range subfield. The predetermined identifier including the number and range subfields is stored in one memory, and data representative of the range subfield are stored in another memory.

The '651 patent is directed to a managing a queue of a jukebox to arrange service identifiers in a queue in order of time of receipt. Requests are ordered in the queue by incrementing the last position identifier in the queue based on inputs received from a customer. There is no suggestion in the '651 patent of either dividing a unique identifier into subfields or,

even if there were, storing portions of the identifier in different memories. The examiner argues that it would have been obvious to store a "working copy" of data in non-volatile memory to prevent loss of data in the event of a power interruption, but even assuming for purposes of argument that the examiner may be correct, that is not what is being claimed. Rather, what is being claimed is dividing the a unique identifier into subfields and storing a portion of the unique identifier in a different memory. The portion being stored in a different memory is not a "working copy," as the examiner posits, but a copy of the predetermined identifier and a subfield of the identifier. Thus, even if one were to modify the '651 patent as theorized by the examiner, one would not arrive at the claimed invention. Instead, one would be led to store the identifier, and only the identifier, in two memories, not to split portions of the identifier for storage in two memories.

Because the '651 patent does not suggest either dividing a unique identifier into subfields or storing portions of the identifier in different memories, claims 16-19, 26-29, and 35-38, as amended, would not have been obvious from that patent to a person of ordinary skill in the art. The rejection under 35 U.S.C. § 103(a) is therefore without foundation and should be withdrawn.

CONCLUSION

Based upon the foregoing amendments and remarks, the application is believed to be in condition for allowance. Withdrawal of all rejections and objections, and an early notice of allowance of claims 16-38 is earnestly solicited.

Respectfully submitted,

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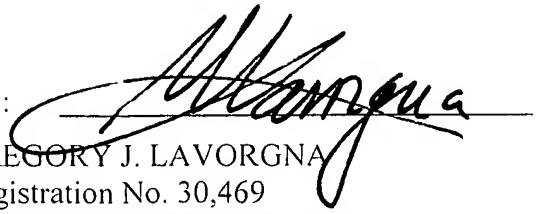
BY: 

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